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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/541,088	03/31/00	ASAMURA	M 1190-0456P

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH VA 22040-0747

EXAMINER	
LEE, Y	
ART UNIT	PAPER NUMBER
2613	

DATE MAILED: 11/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/541,088	Applicant(s) Masako Asamura et al
	Examiner Y. Lee	Art Unit 2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Oct 22, 2001*

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 2, and 6-22* is/are pending in the application.

4a) Of the above, claim(s) *1, 2, and 9-18* is/are withdrawn from consideratio

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-8 and 19-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☒ The proposed drawing correction filed on *Mar 31, 2001* is: a)☒ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☒ All b)☐ Some* c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *08/925,074*.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15)☒ Notice of References Cited (PTO-892)

16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2

18)☐ Interview Summary (PTO-413) Paper No(s). _____

19)☐ Notice of Informal Patent Application (PTO-152)

20)☐ Other:

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of Figures 17-23 upon which claims 6-8 and 19-22 read in Paper No. 6 is acknowledged.

2. Claims 1, 2, and 9-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected embodiment, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/925,074, filed on 9/8/97.

Drawings

5. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 3/31/01 have been approved.

Specification

6. The disclosure is objected to because of the following informalities: page 57, line 31, "22" should be changed to --21--.

Appropriate correction is required.

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

8. The following title is suggested: "Digital VTR for Outputting Normal or Intra-Picture Data Depending on Replay Modes."

Claim Objections

9. Claim 20 is objected to because of the following informalities: line 2, "replying" should be changed to --replaying--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claim 19 recites the limitation "the header appending means" in line 4. There is insufficient antecedent basis for this limitation in the claim.

13. Claims 20-22 recite the limitation "the replay mode" in lines 9 and 8. There is insufficient antecedent basis for this limitation in the claims.

14. Claims 20-22 recite the limitation "the normal replay" in lines 9-10 and 8. There is insufficient antecedent basis for this limitation in the claims.

15. Claim 20 recites the limitation "the still replay" in line 10. There is insufficient antecedent basis for this limitation in the claim.

16. Claim 21 recites the limitation "the fast reply data" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

17. Claim 21 recites the limitation "the reply data" in line 5. There is insufficient antecedent basis for this limitation in the claim.

18. Claim 21 recites the limitation "the slow replay" in line 10. There is insufficient antecedent basis for this limitation in the claim.

19. Claim 22 recites the limitation "the high-speed data" in lines 7-8. There is insufficient antecedent basis for this limitation in the claim.

20. Claim 22 recites the limitation "the fast replay" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

22. Claims 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Lane et al (6,141,486).

Lane et al, in Figures 8, 11, 18, and 19, discloses the same digital VTR for magnetically recording and replaying digitally transmitted bit stream in a predetermined recording format as specified in claims 6-8 of the present invention, comprising division number setting means 1608, responsive to a bit stream input, for stetting the division number into sync blocks that form the recording format (Fig. 17); a predetermined number of transport packets as a unit 106; header appending means 102 for appending, to data of the bit stream before the division, a header indicating the transport packet 1602; format forming means 410 for forming consecutive sync blocks from the data after the division of the bit stream; decoding means 401 for decoding the content of data of an input bit stream; data extracting means 402 for extracting a series of

encoded data used for fast replay, based on the decoded data; and data reducing means 406 for reducing the data amount of the extracted encoded data to a data amount which can be recorded in sync blocks in the predetermined format; wherein the encoded data is recorded repeatedly for a number of times about twice the multiplier of the maximum fast replay speed (Fig. 13).

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

24. Claims 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al in view of Shimoda (5,440,345).

Although Lane et al also discloses detecting means for detecting intra-picture data in the input bit stream; forming means for forming fast replay data from the intra-picture data; recording means for recording the fast replay data together with the normal replay data on a magnetic recording medium; replay means for replaying normal replay data, together with fast replay data from the magnetic recording medium; separating means for separating the normal replay data; storage means for storing the intra-picture data; and switching means for selectively outputting the normal replay data or the intra-picture data stored in the storage means, depending on whether the replay mode is the normal, still, slow, or fast replay, it is noted Lane et al differs from the present invention in that it fails to particularly disclose two headers as specified in claims 19-22. Shimoda however, in Figure 7, teaches the concept of such well known headers wherein a first header for discriminating the fast replay data (P,B) from normal replay data I, and a second header for discriminating, within the normal replay data, the intra-picture data and non-intra-picture data (e.g. backward prediction) from each other.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, having both the references of Lane et al and Shimoda before him/her, to exploit the well known multiple headers appending technique of Shimoda in the digital VTR of Lane et al, in order to provide a high efficient encoding/decoding system for replaying in different data modes.

Conclusion

25. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Or:

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y. Lee whose telephone number is (703) 308-7584.

Y. LEE
PRIMARY EXAMINER

Y. Lee/yl
November 7, 2001